

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Skidmore, *et al.*

Serial No.: 10/632,491

Filed: July 31, 2003

Confirmation No.: 4397

Group Art Unit: 1791

Examiner: Daniels, Matthew J.

Docket No. 190514-1020

For: **Masonry Unit Manufacturing Method**

REPLY BRIEF UNDER 37 C.F.R 41.41

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Sir:

This is a Reply Brief in response to the Examiner's Answer dated October 31, 2007.

I. STATUS OF THE CLAIMS

Claims 1-5, 7-20, and 22-24 remain pending in the present application. The Examiner's Answer maintains the rejections of the claims and generally repeats the arguments advanced in the FINAL Office Action dated August 14, 2006, in addition to providing a Response to Argument section (Section 10, page 10) in reply to the Amended Appeal Brief dated June 28, 2007. With regard to the substantive remarks of the Examiner's Answer, Appellant respectfully disagrees. Appellant will address some issues raised in the Examiner's Answer. Appellant continues to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

II. ARGUMENTS

Appellant addresses some of the rebuttal comments beginning on page 10 of the Examiner's Answer in the following sections below. The failure to address some issues raised in the Examiner's Answer should not be interpreted as an admission of the assertions made in the Examiner's Answer.

A. Independent claim 1, Dependent Claims 2-5 and 23

The Examiner's response beginning on page 10 of the Examiner's Answer is essentially broken down into four components pertaining to the rejection to independent claim 1 and dependent claims 2-5 and 23, and are addressed below in order. As to the first component, page 11 of the Examiner's Answer provides, in part, as follows:

First, Appellants appear to characterize the technological problem to be solved as providing (a) a masonry unit with a filler plug effect, and (b) various bevels through a compression process...It is Examiner's position that one or[sic] ordinary skill in the art at the time of the invention having knowledge of the Whissell and Battle processes, and facing the need of providing a masonry unit with a filler plug effect and various bevels would have found it obvious to combine these processes to provide both a filler plug effect and bevels in view of Battle's teaching of both a filler plug and bevels.

As to case law, the "as a whole" inquiry requires "an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor, would have selected the various elements from the prior art and combined them in the claimed manner." (see

amended Appeal Brief, pages 10-11). As set forth on pages 13-14 of the amended Appeal Brief, *Battle* does not teach a compression process, does not teach a masonry unit as defined in Appellants' specification, and is concerned with the elimination of stresses. In contrast, *Whissell*, as the title of that patent recites, is concerned with compaction for a concrete block molding machine, but as set forth in the FINAL Office Action (page 2), is deficient in the claim limitations of "b) inserting a filler plug into the side of the mold between a partition plate and a pallet and c) a filler plug effect in the compressed mix whereby a masonry unit having a filler plug effect is provided." In other words, *Whissell* teaches nothing about filler plug effects nor mechanisms for achieving filler plug effects, and *Battle* teaches nothing about the claimed masonry units in a compression process. Accordingly, Appellants simply disagree that the combination is obvious.

With regard to motivation to combine, the Examiner's Answer (pages 4 and 11) alleges the following (with section of Examiner's Answer noted parenthetically):

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of *Battle* into that of *Whissell* for the following reasons: a) *Battle* teaches that stripping of the part from a mold causes serious problems since the adherence thereof to the mold itself and to the strips causes stresses to be formed in the precastings, causing deterioration thereof, which *Battle*'s method resolves. B) *Battle* suggests use in precastings, and *Whissell*'s concrete blocks are considered to be precastings. (page 4)

Appellants do not appear to have addressed or particularly argued against this stated motivation. (page 11)

[O]ne of ordinary skill would have been motivated to make the combination of *Battle* with *Whissell* in order to resolve problems encountered in stripping parts from the mold, and it would follow that the filler plug effect and various bevels and filler plug effects would obviously result from the use of *Battle*'s dividers. (page 11)

It appears that the argument supporting a motivation to combine is that both blocks in *Battle* and *Whissell* are allegedly precast. However, Appellants query why other precast patents are not selected, as there are numerous patents that address the subject. In other words, why would one, without the benefit of Appellants' disclosure as a roadmap, combine the non-compression, non-masonry unit art of *Battle* with the compression art of concrete blocks of *Whissell*? For instance, *Whissell* never suggests that there is a stripping stress problem to be addressed, and as explained on page 13 of the amended Appeal Brief, the problems

encountered in non-compression block manufacturing are different than compression-based block manufacturing.

Additionally, Appellants disagree that motivation has not been argued. Appellants direct attention to pages 9-10, pages 11-14, where motivation to combine is indeed disputed. It is also noted, as expressed on pages 12-13 of the Appellants Appeal Brief, motivation to combine is an integral part of the as a whole inquiry.

Further, Appellants wish to correct any perceived mis-statement in the record, namely, though it is believed a motivation to combine has been presented by the Examiner, it is Appellants' position that the motivation is improper.

With regard to the third point (page 12) of the Examiner's Answer, Appellants' respectfully note that all references have been addressed, and not one in exclusion to another.

With regard to the fourth point (page 12) of the Examiner's Answer, it is Appellants' position the rejection of Appellants' claims is based on improper hindsight reasoning, and hence Appellants are uncertain as to why case law would be presented pertaining to allegedly proper hindsight reasoning.

Dependent Claims 7, 8, 9-20

The response of the Examiner's Answer on pages 13-14 address the arguments presented in the amended Appeal Brief as to improper combination as follows (in part):

In response to arguments against Stuckey, it is submitted that careful examination of Fig. 10 shows projections (3) having a bevel shape, and it would have been obvious to provide these bevels with a substantially constant angle. Stuckey appears to teach the same bevel shape in Figs. 1 and 3-6, which reads on the claimed bevel shape having a substantially constant angle of inclination. With regard to Appellants' arguments against an asserted combination of Stuckey with LaCroix, it is submitted that the pertinent question is not whether one is motivated to combine Stuckey with LaCroix, but whether one would have found it obvious to combine the aspects relied upon with Whissell, the base reference for all rejections under consideration.

Appellants respectfully disagree. For instance, it is not obvious to take the time and effort (and hence expense) to manufacture a groove, that is simply used as a fracture point, with a substantially constant angle of inclination. Further, Appellants do not see the groove 30 in

Figures 1 and 3-6, and hence reference to any other bevels, particularly those with a different purpose, is irrelevant to a rejection of the claim language.

Further, with regard to the “pertinent question,” Appellants note that the grounds of rejection for claims 7, 8, and 9-20 was based on a combination of *Whissell*, *Battle*, *Stuckey*, and *LaCroix*. Case law makes it clear that “[t]here is no suggestion to combine . . . if a reference teaches away from its combination with another source. . . A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . .” *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999). Further, as provided in *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986), “[I]t is impermissible within the framework of 35 U.S.C. § 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.” Thus, Appellants believe the above case law supports Appellants rebuttal argument pertaining to the improper combination of *Stuckey* and *LaCroix* as indeed proper, regardless of whether one of these references may allegedly be properly combinable with *Whissell*, an admission of which is neither explicit or implied.

Dependent Claims 9-20

With regard to Knipper and “masonry units,” Appellants appreciate that the Examiner is allowed broad interpretation of the term, as long as it is an interpretation that is consistent with Appellants’ specification as interpreted by one having ordinary skill in the art. As set forth on page 21 of the amended Appeal Brief, concrete window frames are not masonry units as defined by Appellants description.

III. CONCLUSION

Based upon the foregoing discussion, Appellant respectfully requests that the Examiner's final rejection of claims 1-5, 7-20, and 22-24 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims.

No additional fee is believed to be due. However, any additional fee that may be due or required is authorized to be charged to deposit account no. 20-0778.

Respectfully submitted,

/dr/

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